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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,434	11/02/2000	Yuichi Yamagami	2271/62705	4780

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Ivan S Kavrukov
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

PLUCINSKI, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

MAIL DATE	DELIVERY MODE
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09/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/704,434

Applicant(s)

YAMAGAMI ET AL.

Examiner

Jamisue A. Plucinski

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 30-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 30 discloses “determining a second shipping charge corresponding to the actual amount charged by the supplier in step (b) being determined based on shipment of the individual packages from a virtual location in the second country to said customers”, which the examiner considers to be new matter. In the embodiment in the specification where orders in a second country and bundled into one shipment, then dispersed in a first county and shipped to the customer, the second shipping charge is a consolidated shipping charge of all order, and the specification is silent as to determining a second shipping charge corresponding to the individual package. Claim 30 appears to determine the charges for one individual order and compute the difference in charges for one particular package, when the specification only talks about the charges and difference in charges when consolidated.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 19-21, 23, 25-30 and 32-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Arumapuram et al. (US 2002/0019759).

5. With respect to Claim 19, 23 and 30: Arunapuram discloses the use of a method for shipping items which can be from a first country to a second country (Paragraphs 0066 and 0068) comprising the steps:

- a. Receiving by the supplier an order for specified items from a customer
(Paragraphs 0014 and 0038)
- b. Providing to the customer an indication of an amount charged to the customer or shipping the specified items to a customer location (Paragraphs 0021 and 0034);
- c. Fulfilling order in a first country, packaging the items in the first country and consolidating the individual packages for a collective international shipment (Paragraphs 0077 and 0081);
- d. Shipping the collective shipment to a second country (Paragraphs 0077 and 0081)

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- e. Dividing the collective shipment in the second country into individual packages and delivering the packages to the customer (crossdock, paragraph 0077);
- f. Receiving by a supplier an actual charge by the shipping entity to the supplier for transportation of the ordered items from one or more actual supplier locations (See Paragraph 0034)
- g. Providing a first shipping charge (Charge based on Total WD, weight distance, S1 + S2, Page 15, Arunapuram discloses that the rates are calculated for each leg of route as well as total, paragraph 0077);
- h. Providing a second shipping charge related to a virtual supplier location (the examiner considers the cross dock, or the port in the US, to be the virtual location, therefore the second charge would be the charge associated with the second leg of the route, S2);
- i. Computing a difference between the first and second charges (Arunapuram discloses getting the ratios of each leg, and where the rates are associated with each ratio, Paragraphs 0138 and 0140); and
- j. Utilizing the computer difference to manage the allocation of costs (See Paragraphs 0126-0141), or utilizing the difference for managing unbilled shipping charges during a predetermined period of time (Paragraphs 0122 and 0165, as well as 0039, where Arunapuram discloses the orders can be run in batches, therefore the examiner considers this to be a determined time period, however often the batches are run).

- k. Arunapuram discloses the costs are sent to a freight payment module which keeps records in a FP database, which is used in an accounting system (Paragraphs 0052 and 0115), which the examiner considers to be internal cost management, and it is done after the payment is sent to the customer (Paragraph 0118). Arunapuram also discloses that the actual charged cost and the expected costs are used for internally updating rate tables and used for later time in the transportation planning (Paragraph 0124), which the examiner considers to be costs and product planning. Arunapuram further discloses the costs are used for cost allocation (paragraph 0154) and that after the customers are billed, the system determines if there is any internal billing that needs done (Paragraph 0165).
6. With respect to Claims 28 and 29: Arunapuram discloses the first charge includes shipping individual packages within the 2nd country and includes the charge for shipping the collective shipment from the first country to the second country (the examiner considers the first charge to be the total charge, which would include all charges, for each route leg, Paragraphs 0077, and page 15, Total WD).
7. With respect to Claims 20, 21, 25-27, and 32-35: These claims are drawn to intended use of the difference between shipping charges are utilized. The claims recite the difference are utilized “for” product planning, “for” internal cost accounting” etc., without claiming positive limitations on how they are utilized. Therefore the limitations are considered to be intended use, and therefore do not differentiate over the prior art of record and therefore anticipated by Arunapuram.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arunapuram et al. (US 2002/0019759).

10. With respect to Claim 7: Arunapuram, as disclosed above, discloses multiple legs of the route being determined, and shipped using a shipping entity, however fails to disclose the entities which ship the consolidated shipment and the entities which ship the individual shipments are the same entity. This limitation is deemed to be non-functional descriptive material nonfunctional and is not functionally involved in the steps recited. The shipping steps would be performed the same regardless of what entity is actually carrying the shipment. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Arunapuram, to have the shipping entities be the same for the entire route, in order to simplify the freight movement, so there does not have to be any coordination of different entities.

11. Claims 22, 24 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arunapuram in view of Ferguson et al. (5,966,697).

12. With respect to Claims 22, 24, and 31: Arunapuram discloses the use of legs within the transportation of orders, and discloses charging customers based on the legs, however fails to disclose the charge that is provided to the customer is determined without reference to the actual charge by the shipping entity. Fergerson discloses the use of shipping orders, where a customer is charged based on a flat rate, which the examiner considers to be the charge from the customer is determined without reference to the actual charge by the shipping entity (Column 6, lines 14-36). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Arunapuram, to have the charge of the customer be flat rate, and therefore determined without reference to the actual charges by the shipper, as disclosed by Fergerson, due to the fact that, as shown by Fergerson, the use of flat rate shipping is old and well known within the art, in order to simplify the calculation or determination of shipping charges.

Response to Arguments

13. Applicant's arguments filed 6/19/07 have been fully considered but they are not persuasive.

14. With respect to Applicant's argument that Arunapuram does not teach nor suggest several of the features of the claimed subject matter: The applicant has stated that Arunapuram does not teach not suggest determining the differences between the charges which are charged to the supplier by the carrier and the charges which are charged to the customer by the supplier. As stated earlier, the charges are written with terms that are very broad, such as "based on" or "corresponding to", which broadens the limitation from actually claiming that the first charge "is" the charge that is charged to the supplier by the carrier and the second charge "is" the charge

that is charged to the customer by the supplier. Furthermore even though the overall purpose of Arunapuram may be different from the claimed invention. Arunapuram discloses determining the differences between charges, and what is charged, versus proposed charges, and utilizes the differences for the management of costs. As stated above, what they are utilized for in considered to be intended use. The claims are not positively reciting how they are being used, but merely the reasons they are being used. Furthermore, Arunapuram looks at the differences between the estimated costs and actual costs and looks and calculates percentages of shipping costs for the users. The claims as written are very broad claims. Absent any actual calculations or any limitations on how the differences are used to manage, not merely stating broad areas of managing costs, the examiner considers Arunapuram to show the claimed invention. Rejections stand as stated above.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Paulose et al. (US 2001/0027471) discloses the use of aggregating orders for international shipping.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

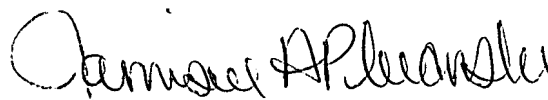
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Plucinski whose telephone number is (571) 272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jamisue Plucinski
Primary Examiner
Art Unit 3629